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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,762	01/26/2004	Thomas J. Moravec	10-9449	8780

37374 7590 11/02/2006

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EXAMINER

NILAND, PATRICK DENNIS

ART UNIT PAPER NUMBER

1714

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/764,762

Applicant(s)

MORAVEC ET AL.

Examiner

Patrick D. Niland

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

1. The amendment of 8/21/06 has been entered. Claims 1-6 and 8 are pending.
2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat.

Application Pub. No. 2004/0207809 Blackburn et al. in view of US Pat. No. 6113813 Goudjil, US Pat. No. 4962013 Tateoka et al., US Pat. No. 5449558 Hasegawa et al., and US Pat. No. 6309313 Peter.

Blackburn discloses photochromic coatings of polyurethane (section [0023] and [0048]-[0052]), the instantly claimed amount of photochromic compound (section [0060]), the instantly claimed thickness (section [0063]), and hindered amine light stabilizers and phenolic antioxidants (section [0088]). UV absorbers are not required of the compositions though they are optionally used. The layers of sections [0022], [0024], and [0025] fall within the scope of the laminate film and "being sandwiched between an inner and outer protective layer of the instant claims. The layer of polyurethane of section [0023] and the other sections noted herein regarding polyurethane photochromic layers are "films" per se. A coating is a film.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the stabilizer mixtures of Goudjil, which fall within the scope of the HALS of the instant claim 3, in the films of Blackburn discussed above because the combinations of HALS and antioxidants encompassed therein are encompassed by Blackburn and would have been expected to give the combinations of benefits taught by Goudjil and Blackburn. See Goudjil, column 5, lines 16-45 and 66-67; column 6, lines 10-26; column 3, lines 59-62; column

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4, lines 18-30; and the remainder of the document. The stabilizer mixtures of Goudjil are expected to prevent polyurethanes from yellowing as taught by Peter, column 10, lines 52-59. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to choose the polyurethane forming monomers of the polyurethanes of Blackburn so as to minimize yellowing as taught throughout Hasegawa, particularly column 4, lines 48-56, because the users of such products dislike discoloration in them, as evidenced by Hasegawa's teaching to use non-yellowing polyurethanes, for various reasons well known to the ordinary skilled artisan.

Reaction injection molding (RIM as is well known and often used in the polyurethane injection molding arts) of the patentee's urethane monomers, which are typically liquids at room temperature, as the injection molding technique of Goudjil would require little or no outside heating, as is extremely well known. Cell casting is not seen to require the argued thermal initiators where urethane monomers of claim 1 of the patentee are used. These initiators are clearly required of the acrylics discussed as non-limiting examples of the resin throughout the patent but they are not required of the well known urethane chemistry. The isocyanate and polyol, i.e. urethane monomers, will react without such initiator or heating. Furthermore, the applicant provides no probative evidence of the applicant's representative's assertions regarding heat degradation. There is no showing that the instantly claimed b* limitation is not met with some heating. Language such as "some circumstances" and "likely" indicate that the applicant's argument does not always apply. It is not stated how much heat is required to cause degradation which gives a b* outside the instant claims nor how much degradation is required to cause b* to be outside the instant claims nor that the patentee's polyurethanes would be outside the instantly claimed b* value where it is cell cast. The patentee does not mention b* per se and therefore

cannot teach away from the instantly claimed b* limitation. These arguments are therefore not persuasive. Furthermore, Goudjil is not cited for the means to put the compounds in the polymer matrix and the methods of shaping the polymer composition. It is cited for the combination of stabilizers and their benefits.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed antioxidant of claim 3 as the antioxidant of Blackburn because it is encompassed by the broad language of Blackburn and Tateoka shows it to be known for use as an antioxidant in similar photochromic films at column 21, structure D-27 and column 27, lines 20-37 and the remainder of the document and it would have been expected to contribute its antioxidant properties to the film of Blackburn.

4. Claims 1-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6113813 Goudjil in view of US Pat. No. 4962013 Tateoka et al. and US Pat. Application Pub. No US 2004/0207809 Blackburn et al..

Goudjil discloses the instantly claimed films and laminates at the abstract; column 2, lines 60-67; column 3, lines 1-22 and 59-62; column 4, lines 1-30 and 58; column 5, lines 15-45, which encompasses the instantly claimed stabilizer mixtures, and 66-67 which encompasses the instantly claimed amount of photochromic compounds; column 6, lines 1-26; column 7, lines 50-58; column 8, lines 1-56, particularly line 2; and the remainder of the document. Since the patentee uses the instantly claimed stabilizer combinations, his films must necessarily and inherently possess the instantly claimed improvement in light fatigue and change in b*.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed combinations of ingredients encompassed by Goudjil in

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the films of Goudjil because they are disclosed by the patentee and would have been expected to give the properties disclosed by the patentee.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed antioxidant of claim 3 as the antioxidant of Goudjil because it is encompassed by the broad language of Goudjil and Tateoka shows it to be known for use as an antioxidant in similar photochromic films at column 21, structure D-27 and column 27, lines 20-37 and the remainder of the document and it would have been expected to contribute its antioxidant properties to the film of Goudjil.

Reaction injection molding (RIM as is well known and often used in the polyurethane injection molding arts) of the patentee's urethane monomers, which are typically liquids at room temperature, as the injection molding technique of Goudjil would require little or no outside heating, as is extremely well known. Cell casting is not seen to require the argued thermal initiators where urethane monomers of claim 1 of the patentee are used. These initiators are clearly required of the acrylics discussed as non-limiting examples of the resin throughout the patent but they are not required of the well known urethane chemistry. The isocyanate and polyol, i.e. urethane monomers, will react without such initiator or heating. Furthermore, the applicant provides no probative evidence of the applicant's representative's assertions regarding heat degradation. There is no showing that the instantly claimed b* limitation is not met with some heating. Language such as "some circumstances" and "likely" indicate that the applicant's argument does not always apply. It is not stated how much heat is required to cause degradation which gives a b* outside the instant claims nor how much degradation is required to cause b* to be outside the instant claims nor that the patentee's polyurethanes would be outside the instantly

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claimed b* value where it is cell cast. The patentee does not mention b* per se and therefore cannot teach away from the instantly claimed b* limitation. These arguments are therefore not persuasive.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to sandwich the photochromic compound of Goudjil between two protective layers according to the instant claims because it is well known to protect soft plastics such as those of Goudjil from scratching by protecting them with hard layers on both sides of the soft plastic, as taught by Balckburn et al., sections [0021]-[0025], particularly section [0025]. The layers of sections [0022], [0024], and [0025] fall within the scope of the laminate film and “being sandwiched between an inner and outer protective layer of the instant claims. The layer of polyurethane of section [0023] and the other sections noted herein regarding polyurethane photochromic layers are “films” per se. A coating is a film. The cited prior art does not require a UV absorber.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

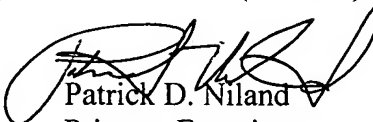
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patrick D. Niland
Primary Examiner
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